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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKKO PORMA and KIMMO HYTONEN

Appeal 2009-014780
Application 10/564,522
Technology Center 3600

Before ROBERT A. CLARKE, CHARLES N. GREENHUT and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a), from a final rejection of claims 1-5. The real party in interest is KCI KONECRANES PLC. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The Claimed Subject Matter

The claimed subject matter is directed to a method of controlling a crane to prevent the undesired swinging of a load fastened to the crane. Independent claim 1 is illustrative of the claims on appeal and is reproduced below:

1. A method for controlling a crane, the method comprising giving velocity requests as control sequences from a crane control system to crane drives and reading and storing the velocity requests (Vref) in a control system, whereby

each velocity request (Vref) is compared with the previous velocity request and, if the velocity request is changed, an acceleration sequence for the corresponding velocity change is formed and stored, after which,

summing the velocity changes defined by the stored acceleration sequences after a particular time interval and adding the obtained sum (dV) to the previous velocity request to achieve a new velocity request (Vref2), which is set as a new control and velocity request for the crane drives, and

performing some of the velocity changes defined by summed acceleration sequences at a definition time of each selected sequence on each control step and performing the rest of them as delayed,

reading and summing the stored sequence parts to be performed as delayed on a plurality of program rounds.

Reference Relied on by the Examiner

Hytonen

US 5,529,193

Jun. 25, 1996

The Rejections on Appeal

1. Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite (Ans. 2).
2. Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hytonen (Ans. 4).

ISSUE

Do claims 1-5 fail to particularly point out and distinctly claim the subject matter which Appellants regard as their invention?

ANALYSIS

The rejection under 35 U.S.C. § 112, second paragraph

The Examiner's Answer lists multiple instances in each of the five claims on appeal wherein Appellants failed to particularly point out and distinctly claim the subject matter which Appellants regard as the invention (Ans. 2-4). Some of the issues cited by the Examiner pertain to a lack of antecedent basis in the claim (Ans. 3-4, 8). Others are cited because the claimed step "is not understood," "the overall sentence structure is awkward," it is "unclear as to what is being claimed," the claim fails to indicate what "is being further limited," the claim is "grammatically incorrect," there is apparent redundancy, a claim limitation "is not fully defined," etc. (Ans. 3-4).

In the first office action mailed Oct. 10, 2007, the Examiner listed multiple reasons for rejecting all the claims under 35 U.S.C. § 112, second paragraph. Appellants subsequently amended the claims and requested reconsideration of the amended application (Amendment mailed March 10,

2008, p. 4). The Examiner repeated many of the same rejections in the Final Office Action mailed June 13, 2008 with an explanation why the previous claim amendments are not acceptable and also presented more reasons for rejection under 35 U.S.C. § 112, second paragraph due to the amendments made. Appellants filed this appeal and did not amend the claims further to put them in better form for appeal (“An amendment presenting rejected claims in better form for consideration on appeal may be admitted” (37 C.F.R. § 1.116(b)(2)). All the claims are presently rejected by the Examiner under 35 U.S.C. § 112, second paragraph for reasons also set forth in the Final Office Action.

In the Appeal Brief, Appellants do not fully address the Examiner’s position. Rather, Appellants address only some of the stated issues of indefiniteness (Br. 7-8). For example, the Examiner rejected claim 1 because the claim phrase “the stored sequence parts” in line 14 lacks antecedent basis (Ans. 3b). The Examiner states that this term “is not introduced into or found in claim 1 in any manner” and that “Appellant’s brief is silent with respect to the basis for this terminology” (Ans. 5). Appellants do not address this matter other than to state that “the scope of claim 1 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art” (Br. 7).

Regarding claim 2, the Examiner addresses the limitation “said control step” and questions what it is and how it has a time aspect (Ans. 3c). Appellants again do not address this limitation other than to state that “the scope of claim 2 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art” (Br. 8). Appellants further do not address all of the rejections of claim 4 or any of the rejections of claims 3

and 5 as set forth in paragraphs d, e, f, g, h or i in the Examiner's Answer (Br. 8, Ans. 3-4). Instead, Appellants state that these claims "would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art" (Br. 8).

We are not persuaded by Appellants contention that claims 1-5 would be clear to one of ordinary skill in the art because, as the Examiner pointed out, the claims contain ambiguities, incomplete phrases, terms lacking antecedent basis and terms which cannot be correlated to the Specification or understood by one of ordinary skill in the art. Appellants have not pointed out the supposed errors in the Examiner's position. Based on the record presented, we sustain the Examiner's rejection of claim 1-5 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

The rejection under 35 U.S.C. § 103(a)

Before a decision based on 35 U.S.C. § 103(a) can be made, "it is essential to know what the claims do in fact cover" (*In re Steele*, 305 F.2d 859, 862 (CCPA 1962)). In *Steele*, the court stated that their "analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims were made by the examiner and the board" and that "we do not think a rejection under 35 U.S.C. § 103 should be based on such speculations and assumptions" (*Id.*). The court continued stating that their

"study of the lengthy record of the Patent Office prosecution provides ample support for our conclusion that substantial confusion exists in the record at all levels of the prosecution as to the proper interpretation to be given to the appealed claims. We believe that this confusion arose and has continued because

the claims do not particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112”
(*Id.* at 863).

Following this example, we are unable to render a decision on the merits of the Examiner’s obviousness rejection as any such decision would be based on speculations and assumptions as to the meaning of the claim terms employed. “If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). We therefore must reverse, *pro forma*, the Examiner’s rejection under 35 U.S.C. § 103.

We note, however, that the Examiner treated claims 1-4 as “mathematical expressions of scientific principles” which the Examiner stated are “a familiar part of the prior art” (Ans. 4). Accordingly, the Examiner deemed that “such algorithms are considered as known prior art” and rejected them under 35 U.S.C. § 103 (Ans. 4¹). The Examiner’s analysis stems from a misinterpretation of *Parker v. Flook*. The cited portion of *Parker v. Flook* refers to “merely the mathematical algorithm” in *contrast* to “the process itself.” These cases are concerned with whether a claim employing a mathematical expression can be inventive under § 101 and are not directed to claims containing an algorithm being prior art under § 103. Moreover, under § 103, it is the claim as a whole, including whether a recitation directed to an algorithm is known in the prior art, that is evaluated. See Application of Prater, 415 F.2d 1393, 1405 (CCPA 1969).

¹ *Citing Mackay Radio and Telegraph Co. v. Radio Corporation of America*, 306 U.S. 86 (1939); *Parker v. Flook*, 437 U.S. 584 (1978) and *Gotschalk v. Benson*, 409 U.S. 67 (1972).

In fact, Congress recently enacted an exception for evaluating an invention under §§ 102 and 103, stating that tax strategies, whether known or unknown, are now deemed insufficient to differentiate a claimed invention from the prior art. Section 14 of the recently enacted America Invents Act states:

For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.

We also note that Appellants' contention rebutting the Examiner's rejection under § 103 is lacking. Appellants simply state "This is not obvious nor disclosed by Hytonen" (Br. 9). Unsupported conclusory statements are entitled to little probative value (*see In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974)).

Nevertheless, we need not reach the merits of the Examiner's obviousness rejection of claims 1-4 in view of Hytonen because we have instead reached a decision concerning the indefiniteness of Claims 1-5. As stated above, it is essential to first know what the claims cover, and as we are not successful in that endeavor, we consider the claims to be indefinite under 35 U.S.C. § 112, second paragraph and do not extend our analysis further.

CONCLUSION OF LAW

Claims 1-5 fail to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

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The merits of the Examiner's rejection under 35 U.S.C. § 103(a) have not been reached.

DECISION

The rejection of claims 1-5 under 35 U.S.C. § 112, second paragraph as being indefinite is affirmed.

The rejection of claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over Hytonen is reversed, *pro forma*. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

MP